



Attorney Docket No: 33332-71679

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Srikanth Rao

Serial No.: 09/845,643 Art Unit: 3711

Filed: April 30, 2001 Examiner: Steven B. Wong

For: EZMARK

AMENDMENT

(Box Non-Fee Amendment)  
Honorable Assistant Commissioner for  
Patents  
Washington, D.C. 20231

RECEIVED  
OCT 24 2002  
TECHNOLOGY CENTER R3700

Sir:

Please amend the claims and the title as indicated in Attachment A. Attachment B is a clean copy.

The interview with examiner Steven Wong on October 21, 2002 is acknowledged with appreciation. At the interview claims 1-10 and new claims 11-15, were discussed. As discussed at the interview, claims 1 and 6 have been amended by incorporating claims 2 and 8, respectively. These amendments avoid the prior art of record.

Claims 1 and 6 as amended require a marker and a clip sized for attachment to a shoe, the clip defining a circular recessed cavity sized and positioned to receive a portion of said marker with one of the clip and marker having a ferrous portion and the other having a magnetic portion. None of the prior art of record, taken alone or in combination, teach or suggest this claimed combination. Hoyt's clip has no magnetic attachment and does not have a cavity sized and positioned to receive a portion of the marker. Giglio's clip is not sized for attachment to a shoe. Other differences, e.g., the tee holders, are evident. And it would not have been obvious to combine Hoyt and Giglio so as to arrive at the claimed invention.

Claims 1 and 6 avoid the prior art references to Tate (U.S. Patent No. 5,305,999) and Kaymen (U.S. Patent No. 4,530,500). Kaymen does not teach or suggest a clip with a cavity sized and positioned to receive a portion of a marker. Tate does not teach or suggest a clip sized for attachment to a shoe, e.g. the space is for thin paper material. In Tate the clip side

holding the marker could not be placed inside the shoe since the marker would be unavailable and, obviously, the divot tool side would not be placed inside the shoe.

Claim 11 requires a monolithic strip with an outer portion having a recess sized to receive a ball marker. None of Hoyt, Giglio, Kaymen and Tate teach or suggest this combination.

Regarding new claim 15, the prior art of record does not teach or suggest the monolithic strip and means for releasably fixing a ball marker to the outer portion of the strip as recited in claim 15. Nor does the prior art teach or suggest an equivalent.<sup>1</sup> The claimed "means for" must be construed to cover the corresponding structure, material or acts described in applicant's specification.<sup>2</sup> None of the prior art markers and supportive structure function in the same manner as described in applicant's disclosure. Of Hoyt, Giglio, Kaymen and Tate, only Hoyt discloses attaching the marker to a shoe and does not suggest a recess or magnet as disclosed by applicant. The others (Giglio, Kaymen and Tate) are not disclosed as usable with a golf shoe and, even if they were attached to a shoe, would not function in the same manner as described in applicant's disclosure.

For all of the above reasons, claims 1, 3-7 and 9-15 are allowable over the prior art of record.

The examiner is invited to telephone the undersigned if there is any issue remaining to be resolve.

A check for \$42 for one additional independent claim is enclosed.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and shortages in other fees, be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 (33332-71679).

Respectfully submitted,  
BARNES & THORNBURG



Richard B. Lazarus  
Reg. No. 48,215  
Tel. No. (202) 289-1313

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<sup>1</sup> The criteria for making a case of equivalence is outlined at Section 2183 of the Manual of Patent Examining Procedure.

<sup>2</sup> See *In re Donaldson*, 29 USPQ 2d, 1845, 1848.